



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,805	06/21/2001	James William Casper	OC527	5082

24959 7590 06/30/2004
PPG INDUSTRIES INC
INTELLECTUAL PROPERTY DEPT
ONE PPG PLACE
PITTSBURGH, PA 15272

EXAMINER

FLETCHER III, WILLIAM P

ART UNIT	PAPER NUMBER
----------	--------------

1762

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/868,805

Applicant(s)

CASPER, JAMES WILLIAM

Examiner

William P. Fletcher III

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 2.

Claim(s) rejected: 1-6, 8-15 and 25-28.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

SHRIVE P. BECK
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

WPF 6/27/2004
William Phillip Fletcher III
Patent Examiner, UPSTO
Group Art Unit 1762

Continuation of 2. NOTE:

2a-1. The claims, if amended as-proposed, would recite a "water-in-oil emulsion." Neither this limitation nor a claim of this scope has, heretofore, been considered by the examiner. Consequently, applicant's proposed amendment will not be entered because entry would require further consideration and/or search.

Continuation of 5. does NOT place the application in condition for allowance because:

5c-1. Applicant's arguments regarding the "water-in-oil emulsion" are moot because they are drawn solely to the claims if amended as proposed. As noted in paragraph 2a-1 above, the proposed amendment will not be entered.

5c-2. Applicant's arguments drawn to Benefiel and the propriety of the combination of Schimmel and Benefiel have been fully considered but are not persuasive.

As an initial point, the examiner again stresses that Benefiel discloses that a carboxy-hydroxy acrylic polymer may be used as a binder in both a pigmented base- and a transparent top-coating composition. Passages in support of this have been repeatedly cited in prior actions. The examiner reproduces the clearest teaching below:

"Another type of film-forming material useful in forming the transparent coating as well as the base coat of this invention is a combination of a cross-linking agent and a carboxy-hydroxy acrylic polymer" (2:61-71).

The examiner's position is clearly and explicitly supported by both this and previously-cited disclosures from Benefiel.

In the prior Office action, the examiner established the motivation for combining Benefiel with Schimmel:

"Since Schimmel gives, as an example of the polymer, an acrylic polymer, but does not give further detail, one of ordinary skill in the art would have looked to the prior art for teachings of suitable acrylic resins. In view of the teaching of Benefiel, it would have been obvious to one of ordinary skill in the art to select, as the acrylic resin, a carboxy-hydroxy resin, as suggested by Benefiel. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of greater control over pigment dispersion and orientation in the composition" (paragraph 4).

From the disclosure of Benefiel, two things are established: (1) that the carboxy-hydroxy acrylic copolymer-based, pigment-containing coating composition of Benefiel advantageously gives greater control over pigment orientation and dispersion; and (2) that such a carboxy-hydroxy acrylic binder is art-recognized as a suitable acrylic binder for a pigmented base-coating composition.

With respect to (1), while applicant correctly notes that this advantage is disclosed in relation to the clear-coat embodiment of Benefiel, it is clearly not limited thereto. It is "especially" an advantage in the clear-coat embodiment (see 6:37-41), but because the base and top-coat formulations are substantially the same (the former additionally containing a colorant), pigment orientation and dispersion are concerns in all pigmented coating compositions, and because Benefiel discloses that the base- and clear-coats contain the same pigments (i.e., aluminum) the binders of Benefiel, one of ordinary skill would reasonably expect a base-coat formulation having Benefiel's carboxy-hydroxy acrylic copolymer as binder to successfully provide the disclosed pigment orientation and dispersion control.

With respect to (2), the examiner notes that selection of a known material (carboxy-hydroxy acrylic copolymer) based on its suitability for its intended use (pigmented, acrylic base-coat binder) has supported a prima facie case of obviousness. See *Sinclar & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945); *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960); and *Ryco, Inc. v. Ag-Bag Corp.*, 857 F.2d 1418, 8 USPQ2d 1323 (Fed. Cir. 1988).

For these reasons, it would have been obvious to one of ordinary skill in the art to select, as the acrylic resin, a carboxy-hydroxy acrylic copolymer resin as suggested by Benefiel. One of ordinary skill in the art would have been motivated to do so by the desire and expectation of successfully achieving greater control over pigment dispersion and orientation in the composition.

WPF 6/27/2004